

6. Claim 95.

Applicants provisionally elect to prosecute group 1, claims 50-52 and 54-57. This election is made with traverse for the reasons set forth below.

Applicants assert that the secondary restriction requirement is improper. If the Examiner wishes to break down the claims into various elements/embodiments, the proper way to do so is by an election of species requirement. Such a requirement should set forth various species identified by groups of figures and require the Applicants to elect a species and select the claims that read on the elected species. The Examiner instead has apparently attempted to make an election requirement by breaking the groups of claims down by elements. However, by classifying all of claims 50-88, 94-96, 99, and 100 as being drawn to a single invention in Group II, characterized as a method of wrapping a load, on page 2 of the Office Action, the Examiner has already categorized these claims as being related to the practice of a single invention. To further sub-divide these claims by element and state that the inventions of groups 1-6 are unrelated (page 4 of the office action), after the Examiner has already classified these claims as being drawn to a single invention, is entirely improper and contradictory.

Applicants further contest this secondary restriction requirement for the following reasons. In the Office Action, the claims of Group II were sub-divided into groups 1-6. Groups 1-6 were restricted because, for example, according to the Office Action, the claims of group 1 require a groove in a roller and the claims of group 2 do not and instead recite the position of the roller. See Office Action, page 4.

Citing MPEP §§ 806.04 & 808.01, the Office Action suggests that the claims of groups 1-6 are independent of one another. See Office Action, page 4. However, for

the claims of the invention to be independent, the claims must be directed to different combinations, not disclosed as capable of use together, having different modes of operation, or different functions or effects. See MPEP § 806.04. The MPEP continues with some examples of independent inventions. One example is an article of apparel, such as a shoe or necktie, and a locomotive bearing. See id.; § MPEP 808.01, Examiner Note. Another example is a process of painting a house and a process of boring a well. See MPEP § 806.04.

While the meaning of the terms used in the MPEP to define “independent” inventions may be vague, the examples provided for context are not. In order for the Groups of claims to be restricted as being directed to independent inventions, the claims must be directed to entirely and completely different subject matter. In fact, the MPEP explicitly states that independent inventions are “but rarely presented, since persons will seldom file an application containing disclosures of independent things.” See § MPEP 808.01. This suggests that independent inventions are entirely and absolutely exclusive of one another. This is not the case in the groups of claims cited in the secondary restriction in the present application.

In contrast to the examples of independent inventions set forth in the MPEP, the claims of groups 1-6 in the present application are all directed toward a method of wrapping a load. Indeed, the fact that the claims of groups 1-6 are not directed toward “independent” inventions was acknowledged by the Examiner on page 2 of the Office Action, where the claims of groups 1-6 were classified together as the single invention of Group II. The subject matter of the claims of groups 1-6 is not independent as would be a necktie and a locomotive bearing. Therefore, the claims are not independent as suggested in the Office Action.

In addition to requiring that the inventions of groups 1-6 be independent of one another, a proper restriction would require that examination of all groups of claims impose a serious burden on the Examiner. See MPEP § 803.01. A serious burden may be shown by appropriate explanation of separate classification or separate status in the art, or a different field of search. See id. Accordingly, even if the claims of groups 1-6 were found to be independent as suggested in the Office Action, a restriction cannot be sustained unless the Examiner shows by appropriate explanation that, in addition to being independent, groups 1-6 have one of the following elements: (A) separate classification; (B) separate status in the art; and (C) different field of search. See MPEP § 808.02. Where “the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” Id.

This same section of the MPEP defines the above-required elements as follows:

(A) **Separate classification thereof:** This shows that each distinct subject has attained recognition in the art as a separate subject for inventive effort, and also a separate field of search. Patents need not be cited to show separate classification.

(B) **A separate status in the art when they are classifiable together:** Even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors. Separate status in the art may be shown by citing patents which are evidence of such separate status, and also of a separate field of search.

(C) **A different field of search:** Where it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search. MPEP § 808.02.

First, Applicants submit that the Examiner has not established that the claims of Groups 1-6 have a separate classification, as set forth above in Element (A). The Office Action indicates that the claims of each of groups 1-6 are classified in class 53, subclass 399. See Office Action, page 2. Accordingly, instead of being separate, the Office Action indicates that groups 1-6 have the same classification. Because groups 1-6 have the same classification, Element (A) requiring a separate classification is not met. Therefore, the claims of the application cannot be restricted based on the first element.

Element (B) required for proper restriction is present when the inventions have formed a separate status in the art. A separate status in the art may be shown by citing patents which are evidence of such a separate status, and also a separate field of search. See MPEP § 808.02. However, Applicants have not received any evidence that the inventions have formed a separate status in the art. The Office Action does not cite any patents as evidence showing any status of any of groups 1-6. Applicants submit that in the absence of such citations and evidence, it cannot be presumed that groups 1-6 have formed a separate status in the art. Because the claims of groups 1-6 have not formed a separate status in the art, evidenced by cited patents, Element (B) required for proper restriction is not present.

Finally, Element (C) required for proper restriction is present when the groups require a different field of search. The Office Action does not make any such allegation.

Further, as defined in the MPEP, a different field of search exists only “[w]here it is necessary to search for one of the distinct subjects in places where no pertinent art to the other subject exists.” See MPEP § 808.02(c) (emphasis added). This requirement is not met. Instead, if the Examiner were to search the claims of group 1, for example, the places searched would likely contain pertinent art to the claims of Groups 2-6. This position is supported by the Examiner’s classification of all of the claims in groups 1-6 as being classified not only in the same class (53), but also the same subclass (399). There is nothing to suggest that the field of search would be different than the classification. Accordingly, the claims of groups 1-6 do not require a separate field of search when considered in view of the MPEP.

In summary, based on the above, Applicants submit that the Examiner has not established that groups 1-6 are independent or that groups 1-6 possess a separate classification, a separate status in the art, or a different field of search. In addition, Applicants submit that groups 1-6 relate to the same general subject matter (e.g., methods for wrapping a load), have the same classification, have not attained a separate status in the art, and do not require different fields of search. “Where ... the classification is the same and the field of search is the same and there is not clear indication of separate future classification and field of search, no reasons exist for dividing among related inventions.” See MPEP § 808.02 (emphasis added). Thus, Applicants contend that there is no reason to restrict the claims of any of groups 1-6 from one another. Accordingly, Applicants request that the secondary restriction requirement be withdrawn and groups 1-6 be examined on the merits in this application.

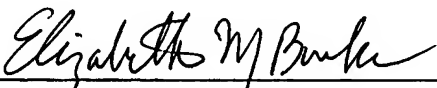
The Office Action contains characterizations of the claims with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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